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10/057,476	01/24/2002	Craig A. Schell	P-TN-2547	3550

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EXAMINER

TRAN, LOUIS B

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3721

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 04222004

Application Number: 10/057,476
Filing Date: January 24, 2002
Appellant(s): SCHELL ET AL.

Adan Ayala
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 10, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claim 3 stands by itself and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,785,228	Fa et al.	07/1998
5,823,395	Foster et al.	10-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fa et al. (5,785,228) in view of Foster et al. (5,823,395). This rejection is set forth in prior Office Action, Paper No. 13.

With respect to claim 3, Fa et al. teaches the use of a fastener tool comprising a housing a magazine 5 connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a contact trip 14 assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece, a trigger assembly pivotally attached to the housing for activating the driving mechanism, said trigger assembly being rotatable relative to the housing about a first axis, said trigger assembly comprising a main trigger 10 pivotally attached to the housing, and a supplemental trigger 12 pivotally attached to the main trigger, said supplemental trigger being movable by the contact trip assembly, said driving mechanism being activated only when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger but does not show a trigger lock disposed between the housing the trigger assembly, the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing

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the trigger assembly from activating the driving mechanism and a second position not preventing the trigger assembly from activating the driving mechanism position, the trigger lock having a handle for moving the trigger lock between the first and second positions, said handle being rotatable with the trigger lock about the second axis

However, Foster et al. teaches a trigger lock disposed between the housing the trigger assembly, the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism and a second position not preventing the trigger assembly from activating the driving mechanism position, the trigger lock having a handle for moving the trigger lock between the first and second positions, said handle being rotatable with the trigger lock about the second axis, as in column 7 line 30, relative to the housing for the purpose of safe operation as in column 1, lines 5-31.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Fa et al. with a trigger lock with a specific axis orientation in order to provide safe operation.

(11) Response to Argument

Applicant has admitted on page 5 of the Appeal Brief that Fa et al. shows specific elements of the Appellant's invention but does not show a trigger lock disposed between the housing and trigger assembly with a specific axis of rotation. Examiner has relied upon Foster et al. to show a trigger lock disposed between the housing and trigger assembly with a specific axis of rotation.

Appellant contends that Foster et al. is not analogous art because a person of ordinary skill in the fastener tool arts would not look in the dispenser field for a solution. Appellant relies on *In re Oetiker* (cited by Examiner) to support the contention that Foster et al. is not reasonably pertinent to the problem and not in the field of the Appellant's endeavor. 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Finally, Appellant contends that a person of ordinary skill, seeking to solve a problem of preventing unintended triggering of a fastener gun by an adult, would not reasonably look for a solution in the child-proof dispenser field.

The question presented is whether one of ordinary skill in the art would look to other trigger lock mechanisms to solve the particular problem at hand.

Although Appellant relies upon *In re Oetiker* to show common law precedent regarding non-analogous art, the ruling of *In re Oetiker* is materially and factually distinguishable from the current facts pending.

The P.T.O. in *In re Oetiker* relied on a garment hook in establishing a *prima facie* case of obviousness to combine with a hose clamp application. *Id.* at 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Examiner agrees with the United States Court of Appeals ruling that one of ordinary skill in the art specialized in hose clamps would not look to the garment hook field for solutions to a problem. The purpose and application of hooks applied to hose clamps and hooks applied to garments are vastly disparate in nature and operational intent.

However, a trigger from a fastener tool and a trigger from a pump dispenser are unequivocally analogous in purpose and application. In both applications, the trigger lock is meant to prevent the actuation of a trigger.

More importantly, preventing the actuation of a trigger would prevent the unwanted dispensing or firing of a harmful product or fastener. Unlike hooks on garments and hoses, trigger locks of dispensers and tools share the same solution to the same problem of preventing triggering and release of unwanted product. Trigger locks in dispensing applications are *reasonably pertinent* to fastener dispensing applications and have identical operational intent.

The Court of Appeals noted, "consider ...common sense - - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" *Id. at* 1446, 1447 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

One of ordinary skill solving a problem related to trigger locks would be expected to turn to other classifications, such as dispensing, to prevent the unwanted dispensing of a product out of common sense. Even though Foster et al. is not explicitly classified in tools, the dispenser field and fastener dispensing field have inherently overlapping subject matter. Trigger locks from both applications are in the *same field of endeavor*.

The primary intent of a trigger lock is to prevent inadvertent actuation of a trigger with no distinction of whether a child or an adult is present. Appellant contends that there is a distinction between the prior art since Appellant's trigger lock is for adults and the pump dispenser trigger lock of Foster et al. is for children. However, Appellant's

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adult-proof trigger lock would effectively be characterized as a child-proof trigger lock and therefore no distinction can be made.

It should be noted that the prior art of record shows the notoriously well-known and common use of trigger locks in fastener tool applications. Foster et al. is relied upon to overcome the structural limitations presented by amendment to the claims during prosecution.

In conclusion, Foster et al. provides the same solution as Appellant's invention to the same problem of unwanted dispensing of product. Foster et al. is reasonably pertinent to the particular problem and within the same field of endeavor, and the ruling of *In re Oetiker* is distinguished by the specific facts presented.

For the above reasons, it is urged that the rejections should be sustained.

Respectfully submitted,

Louis Tran

Stephen F. Gerrity
Stephen F. Gerrity
Primary Examiner

LBT
April 23, 2004

Conferees:
Louis Tran
Scott Smith
Steve Gerrity

[Handwritten signatures of Louis Tran, Scott Smith, and Steve Gerrity]

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